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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/049,219 | 01/17/2002 | Bernard Danner | 1999CH006 | 9387 |

25255 7590 11/03/2004

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

KUMAR, PREETI

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1751

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,219

Applicant(s)

DANNER ET AL.

Examiner

Preeti Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-26, 29 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 29 and 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 29 and 37-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Final Rejection after RCE

Response to Amendment

1. Claims 18-26 and 29, 37-39 are pending.
2. The objection to claims 19, 21-26 and 29 is withdrawn in light of applicant's amendment to the claims.
3. The objection to claims 18 and 20 is maintained because of the following informalities: In claim 18, the amendment made to claim 18 recites "... wherein the molar ratio of the adducts...". Examiner does not see support or basis for this amendments, as proven by the previous claim 18 which recited that the molar ratio of the (ethylene oxide)/ propylene glycol + polyethylene glycols is in the range from 0.04 to 0.3. The claim as amended limits only the molar ratio of the ethylene oxide.
4. The rejection of claims 27-29, 32-33 under 35 U.S.C. 112, second paragraph, is withdrawn in light of applicant's cancellation of claims 27 and 28 and in light of Applicants amendment to claim 29 making it an independent product claim.

Newly submitted claims 29, 37-39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The invention originally claimed is drawn to a method of treating a textile with a polyester produced from a propylene glycol or polyethylene glycol and encapped with monofunctional adducts of ethylene oxide onto a C1-4 alkanol as recited in the independent claim 18. The amended independent claim 29 and newly added claims 37-39, are drawn to a lubricant composition consisting of a polyester and a thickening

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agent. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29 and 37-39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. The rejection of claims 18-21 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Joyner et al. (US 4,483,969) is maintained for the reasons recited in the previous office actions.

6. The rejection of claims 18-26 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Miracle et al. (US 5,576,282) is maintained for the reasons recited in the previous office actions.

Response to Arguments

7. Applicant's arguments filed August 6, 2004 have been fully considered but they are not persuasive.

Applicant's urge that Joyner et al. fail to teach or provide motivation to substitute the polyfunctional end caps with Applicants claimed monofunctional adducts. Contrary to applicants arguments that Joyner et al. fail to teach or suggest ethylene oxide as an end cap moiety, please see col.1, ln.65-col.2, ln.30. where Joyner et al. teach polyester waxes encapped with ethylene glycol, 1,3-propanediol, propylene glycol, 1,4-butanediol, 1,5-pentanediol, 1,6-hexanediol, 1,8-octanediol, 1,4-cyclohexanedimethanol, 1,3-cyclohexanedimethanol, 2,2-dimethyl-1,3-propanediol, 2,2,4,4-tetramethyl-1,3-cyclobutanediol, diethylene glycol, poly(oxyethylene)glycol, and the like. Joyner et al.

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teach that these end capped, functionalized polyester waxes may be coemulsified with oxidized polyethylene or ethylene telomer waxes or with low molecular weight ethylene/acrylic acid copolymer waxes. Such emulsions are useful in textile treatment. Applicants argument that the prior art is limited to polyfunctional end caps and the instant claims are limited to monofunctional endcaps is not found persuasive as the prior art teaches suitable endcap moieties which are the same as the encap moities recited by the instant claims. Specifically Joyner et al. teach a polyester reacted with propylene glycol or ethylene glycol, (ln.13) with dicarboxylic acids or terephthalic acid (ln.4-5) and with oxyethylene glycol. See col.2, ln.4-18. Examiner is aware that the prior art recites the endcaps as polyfunctional, and the claims are drawn to monofunctional. However, prior art teaches the same endcap moieties as those recited by the material limitations of the instant claims, thus, the prior art teaches and provides motivation to use polyfunctional or monofunctional endcaps.

Applicant's urge that Miracle et al. is directed to a bleach booster and detergent composition and does not teach or suggest a method for treating a textile piece good wherein the claimed polyester is added to the aqueous bath in order to prevent transportation folds or friction in or on the substrate during the processing of the textile. Contrary to Applicant's arguments that Miracle et al. do not teach a method for treating textile, please see example VIII, where Miracle et al. teach a laundry detergent composition comprising polyethylene glycol, brightener, polyacrylic acid, and an anionic surfactant as recited by the instant claim. Thus, the prior art illustrates placing the claimed polyester in an aqueous bath to treat a textile. Also contrary to applicants,

arguments, the teachings of Miracle et al. are sufficient to one of ordinary skill in the art to arrive at a method for a treatment of textile piece goods under conditions which would not favor the formation of transport folds as recited by the instant claims because Miracle et al. teach a method of treating laundry with a laundry detergent composition having bleach effectiveness in lower temperature solutions and superior color safety profiles comprising the same components as recited by the instant.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amendment made to claim 20 recites "... a polyester made from the compounds as described above...". This is indefinite because the limitation recited does not make clear or define the boundaries of the subject matter for which patent protection is sought.

Conclusion

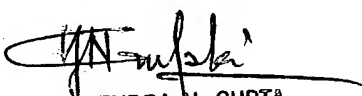
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 571-272-1320. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


YOGENDRA N. GUPTA
SUPERVISORY PATENT EXAMINER
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Examiner Preeti Kumar
Art Unit 1751